## REMARKS

The present application was filed on October 9, 2001 with claims 1-12. Claims 1, 4-6 and 9-12 are the independent claims.

In the outstanding Office Action, the Examiner: (i) rejected claims 1, 3-6 and 8-12 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,665,659 to Logan (hereinafter "Logan"); and (ii) rejected claims 2 and 7 under 35 U.S.C. §103(a) as being unpatentable over Logan in view of U.S. Patent No. 5,584,022 to Kikuchi et al. (hereinafter "Kikuchi").

In this response, Applicants: (i) amend independent claims 1, 4-6 and 9-12; (ii) cancel claims 2 and 7; and (iii) traverse the various §102(e) and §103(a) rejections for at least the following reasons.

Regarding the §102(e) rejection of amended independent claims 1, 4-6 and 9-12, Applicants assert that Logan fails to teach or suggest all of the limitations in said claims for at least the reasons presented below.

It is well-established law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicants assert that the rejection based on Logan does not meet this basic legal requirement, as will be explained below.

By way of example, the invention of amended independent claim 1 recites an information distribution method, for a network system including a first information processing apparatus for providing information, a second information processing apparatus for obtaining said information, and a network for connecting said first and said second information processing apparatuses, comprising the steps of: said first information processing apparatus recording first information for a user; said second information processing apparatus recording second information for said user; said first information processing apparatus, while referring to said first information, generating a single first choice or multiple first choices concerning said information; said second information processing apparatus receiving said first single or multiple choices from said first information processing apparatus via said network; said second information processing apparatus, while referring to said

second information, selecting as a single second choice said single first choice or selecting multiple second choices from among said multiple first choices concerning said information; said second information processing apparatus requesting that said first information processing apparatus obtain part or all of said information correlated with said single second choice or said multiple second choices; said first information processing apparatus transmitting said requested information to said second information processing apparatus, and said second information processing apparatus receiving said requested information; and said second information processing apparatus displaying said received information; wherein said first information is information concerning said user that can be disclosed, and said second information is secret information held by said user. Applicants have amended claim 1 to include the above-underlined language. As is evident, such added language comes from canceled dependent claim 2. Independent claims 4-6 and 9-12 recite similar limitations and have been amended in a similar manner.

By way of example, as illustratively explained in the present specification at page 5, line 22, through page 6, line 15, when the "first processing apparatus" is an information distribution server and the "second processing apparatus" is a user terminal:

> According to the method and system of this invention, personal information that should be kept secret [e.g., second information] is retained by a user's terminal, and is not available at the information distribution server. Therefore, greater secrecy can be afforded personal information, and the system can be safely employed by a user. This will encourage many more users to employ the service, and more effective use of the information distribution system can be provided. Further, only attribute information is used for the first and the second choices. That is, during the process performed to filter the information, the attribute information, for which volume is small, rather than the main body of the information, for which volume is large, is exchanged by the information distribution server and the user's terminal. Later, after the information has been satisfactorily filtered, the main body of the information, for which the volume is large, is exchanged. As a result, the communication load and the operating load imposed on the information processing apparatuses can be reduced. It should be Further noted that the user's access history can be included in the second information.

As acknowledged in the present Office Action at page 14, "Logan fails to teach said second information is secret information held by said user." For at least this reason, Applicants assert that claims 1, 3-6 and 8-12 are patentable over Logan.

Applicants now turn to the rejection of claims 2 and 7 under §103(a) as being unpatentable over the combination of Logan and Kikuchi. Such dependent claims were canceled; however, the subject matter of claim 2 (which is similar to that of claim 7) was effectively incorporated into independent claims 1, 4-6 and 9-12. Thus, Applicants will address the §103(a) rejection with respect to the amended independent claims.

Applicants respectfully assert that the Logan/Kikuchi combination fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143.

As set forth in M.P.E.P. §2143, three requirements must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited combination must teach or suggest all the claim limitations. While it is sufficient to show that a prima facie case of obviousness has not been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, there is a clear lack of motivation to combine the references. For at least this reason, a prima facie case of obviousness has not been established. Logan is directed to a method of selectively distributing information from a multiplicity of information sources using metadata (called "citations") such that the most useful information is directed to those users who have the greatest need or desire for it (Abstract and column 1, lines 13-17, of Logan), while Kikuchi is directed to an enciphered file sharing method wherein privacy is maintained by forming files that are only accessible by authorized persons (column 1, lines 6-11, of Kikuchi). That is, the teachings in each reference provide completely different solutions to completely different problems; one (Logan) toward metadata distribution services that focus on providing a requestor with the most relevant information, the other (Kikuchi) toward an enciphered file sharing method. However, other than a very general and conclusory statement in the Office Action, there is nothing in the two references that reasonably suggests why one would actually combine the teachings of these two references.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id. at 1343-1344.

In the Office Action at page 14, the Examiner provides the following statement to prove motivation to combine Logan and Kikuchi, with emphasis supplied: "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify Logan in view of Kikuchi to provide said second information is secret information held by said user . . . . [since o]ne would be motivated to do so to allow privacy among users (abstract)."

Applicants submit that this statement is based on the type of "subjective belief and unknown authority" that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination. The Office Action cites, presumably, the abstract of Logan (since it is stated that "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Logan"); however, Logan mentions nothing about privacy concerns with respect to the use of the distribution of metadata. On the other hand, even if the Office Action is referring to the abstract of Kikuchi, Kikuchi mentions nothing about information relevance concerns with respect to file sharing.

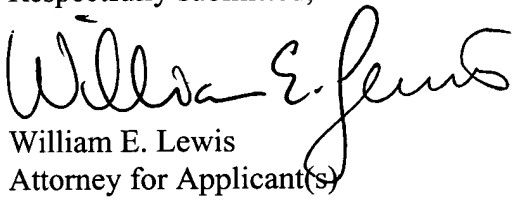
Second, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Logan and Kikuchi. For at least this reason, a prima facie case of obviousness has not been established. Despite the assertion in the Office Action, Applicants do not believe that Logan and Kikuchi are combinable since it is not clear how one would combine them. There is no guidance provided in the Office Action. However, even if combined, for the sake of argument, they would not achieve the unique techniques of the claimed invention.

Third, Applicants assert that even if combined, the Logan/Kikuchi combination fails to teach or suggest all of the limitations of the claims. For at least this reason, a prima facie case of obviousness has not been established.

By way of example only, the Logan/Kikuchi combination, at least, fails to teach or suggest "second information processing apparatus, while referring to said second information, selecting as a single second choice said single first choice or selecting multiple second choices from among said multiple first choices concerning said information . . . wherein . . . said second information is secret information held by said user," is in the claimed invention

In view of the above, Applicants believe that claims 1-12 are in condition for allowance, and respectfully request withdrawal of the §102(e) and §103(a) rejections.

Respectfully submitted,



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